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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,075	01/08/2004	Holger Hoppe	543822003100	5426
25227	7590	02/24/2005		
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			EXAMINER CHAN, EMILY Y	
			ART UNIT 2829	PAPER NUMBER

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/753,075

Applicant(s)

HOPPE, HOLGER

Examiner

Emily Y. Chan

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

In claim 6, the recitation " the metal alloy" lacks antecedent basis.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-11 and 13-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-9 and 11-14 of copending Application No. 10/753082. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1, 9, 11, 13 and 15 of the instant application and the claims 1, 11 and 14 of co-pending application (10/735082) are directed to the same socket or adapter device and the same method for testing semiconductor devices. The claimed components associated with functions recited in the claims 1, 9, 11 and 13 of the instant application such as "a socket or adaptor", "at least one connection pin"; "a contact device" are all recited in the claims 1, and 11 of the co-pending application (10/735082). The components and steps

recited in the method claim 14 of the instant application are all recited in the method claim 15 of the co-pending application (10/735082). Therefore, the co-pending application (10/735082) encompasses the scope of the instant application. Claims 2-5 of the instant application are identical to the claims 2-5 of the co-pending application (10/735082). Claim 6 of the co-pending application (10/735082) recites the one section of pin with a curved shape, which encompasses the bent shape as claimed in claim 6 of the instant application. Claims 8-9 of the instant application are identical to the claims 7-8 of the co-pending application (10/735082). Claims 12-13 of the instant application are identical to the claims 10 and 14 of the co-pending application (10/735082).

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Pfaff et al US patent No. 6,124,720.

With respect claims 1 and 7-10, Pfaff et al ('720) disclose a burn-in test sockets or adapter device for surface mount device packages (see Figs 1-4, 10) as claimed, comprising at least one connection pin (11) configured to be connected to a corresponding contact device (contact pad 41) (see Fig. 3) of a device (circuit board

40), wherein the connection pin (11) is configured to be connected to the contact device (41) by solderless surface mounting (see Col. 4, lines 9-10, "high pressure or gas-tight engagement with the contact pad 41").

With respect to claim 2, Pfaff et al ('720) s socket or adapter device (100) is semiconductor device testing socket or a semiconductor device testing adapter, respectively, which is configured for testing a semiconductor device (see Col. 4, line 21, device package 20).

With respect to claim 3; Pfaff et al ('720)'s socket or adapter device (10) is a burn-in testing socket or a burn-in testing adapter.

With respect to claims 4-6, Pfaff et al ('720)'s connection pin (11) is made of a flexible or resilient material such as gold-plated steel or alloys such as beryllium-copper alloy (see Col. 3, lines 16-21) and has an arcuate or bent shape (curved beam 15,16) (see figs. 3-4).

With respect to claims 11 and 13, Pfaff et al ('720) disclose clamps device (see Figs 1,3-4, elements 61,62, 51,52,53) such that the connection pin (11) is connected to the contact device (41) without soldering.

With respect to claim 14, Pfaff et al ('720) 's socket or adapter device (100) comprises a plurality of connection pins (11), each being connected to corresponding contact device (41) without soldering (see Col. 3, line 38, "plurality of such contact pins").

With respect to claim 15, Pfaff et al ('720) disclose a method for testing semiconductor devices (see Figs 1-3), comprising:

connecting a socket or adapter device (100) to a testing system (40) wherein at least one connection pin (11) is connected to a corresponding contact device (41);

loading the socket or adapter device (100) with a semiconductor device (20) to be tested, wherein the connection of the connection pin (11) to the contact device (41) is performed by solderless surface mounting.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfaff et al ('720) in view of Volz et al US patent No. 5,273,441.

Pfaff et al ('720) do not disclose an appropriate screw connection.

Carney et al ('592) disclose a test fixture (see Fig. 1) and particularly teach a screw (12) for an appropriate screw connection.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to incorporate Carney et al ('592) 's screw connection in Pfaff et al ('720) 's system for the expected benefit of providing a test fixture in which multiple circuit boards can be quickly connected and released without requiring time-consuming alignment of the connector as disclosed by Carney et al ('592) (see Col. 1, lines 45-48).

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Akram et al US patent No. 6,072,326 disclose a socket adapter device for testing semiconductor device (see Figs 1-3, 16) comprising at least one connection pin (28) configured to be connected to a corresponding contact device of test board (14) by solderless surface mounting.

Volz et al US patent No. 5,273,441 disclose a burn-in socket (10) including a clamping means.

Response to Arguments

Applicant's arguments with respect to claim 1-11 and 13-15 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Y. Chan whose telephone number is 571-272-1956. The examiner can normally be reached on 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 571-272-2034. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EC
2-18-05


VINH NGUYEN
PRIMARY EXAMINER
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02/22/05